

03-0872

REMARKS

Claims 1-20 are in the case and subject to a restriction requirement. Claims 7-12 and 14-15 are rejected under 35 USC § 102 over USPA 2002/0130049 to Chen et al. Claims 7, 9, and 11-15 are rejected under 35 USC § 102 over USPA 2003/0114087 to Duboust et al. Claim 7 has been amended. No new matter has been introduced by the amendments, which are supported by the disclosure of the original specification, such as in paragraph [0036], and figure 1. Reconsideration and allowance of the claims are respectfully requested.

RESTRICTION REQUIREMENT

Claims 1-20 are in the case and subject to a restriction requirement. Applicants hereby confirm the provisional election with traverse to prosecute the claims of Group II, including claims 7-15. Thus, claims 1-6 and 16-20 are withdrawn from consideration. Reconsideration is requested.

However, restriction is not required by 35 U.S.C. § 121, as suggested in the office action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. § 121 "... the Commissioner *may* require the application to be restricted..." (emphasis added). Likewise, MPEP § 803 lists two criteria that must be present for restriction to be proper:

1. The invention must be independent or distinct; and
2. There must be a *serious burden* on the examiner if restriction is not required, *even if there are independent and distinct inventions present*.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. Further, the examiner will undoubtedly use electronic search methods to find the prior art. Thus, even if the claims cover material that is found in separate classifications, there is no burden to search these separate classifications using electronic methods. Typically, the examiner will need to search multiple classifications anyway, to ensure that no relevant art is overlooked.

03-0872

In addition, even if there is *some* additional burden on the examiner in searching the additional classifications, the number of claims in the present application is not great, and thus there certainly is no *serious* burden in searching the relevant classifications. Further yet, the claims are all directed to art that is extremely related, and do not require searching classifications that are significantly different, one from another. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP § 803, in keeping the claims together.

Further, in maintaining the restriction, the examiner is locking the Patent Office into the position that the two groups of claims are patentable over each other, as provided by MPEP 802.01. Thus, if the restriction is maintained and both sets of claims are eventually allowed, the patents could not be cited against one another under either statutory double-patenting or the judicially created doctrine of double-patenting, and no terminal disclaimer could be required. Taking such a definitive position should be carefully weighed before the restriction requirement is maintained for a mere matter of convenience.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

CLAIM REJECTIONS UNDER §102

Claims 7-15 are rejected under 35 U.S.C. 102 as being unpatentable over one or both of Chen et al. and Duboust et al. Independent claim # claims, *inter alia*, a method for thinning a layer on a substrate by *bringing the substrate completely into a bath of an electrolyte solution*, and forcing an *electropolishing pad that is mounted completely within the bath of the electrolyte solution* against the layer while applying a desired voltage potential through an the electrolyte solution between the substrate and the electropolishing pad, *with both the substrate and the electropolishing pad entirely*

03-0872

contained within the bath of the electrolyte solution, where the layer is thinned both physically by the electropolishing pad and electrolytically by the voltage potential applied through the electrolyte solution.

Neither Chen et al. nor Duboust et al., nor the combination of the two, describe this method where both the substrate and the electropolishing pad are entirely contained with the bath of the electrolyte solution. Thus, claim 7 patentably defines over both Chen et al. and Duboust et al. Reconsideration and allowance of claim 7 are respectfully requested. Dependent claims 8-15 depend from independent claim 7, and contain additional important aspects of the invention. Therefore, dependent claims 8-15 patentably define over both Chen et al. and Duboust et al. Reconsideration and allowance of dependent claims 8-15 are respectfully requested.


CONCLUSION

Applicants assert that the claims of the present application patentably define over the prior art made of record and not relied upon for the same reasons as given above. Applicants respectfully submit that a full and complete response to the office action is provided herein, and that the application is now fully in condition for allowance. Action in accordance therewith is respectfully requested.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension be charged to deposit account 12-2355. If other fees are required by this amendment, such as fees for additional claims, such fees may be charged to deposit account 12-2252.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

Rick Barnes, 39,596

2006.01.24